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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,802	03/03/2004	Toshimichi Ogisu	032405R165	4350
441 7590 12/27/2006 SMITH, GAMBRELL & RUSSELL 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			EXAMINER EDWARDS, NEWTON O	
			ART UNIT	PAPER NUMBER
			1774	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/27/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/790,802

Applicant(s)

OGISU, TOSHIMICHI

Examiner

N Edwards

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3 and 4 is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/26/06</u> | 6) <input type="checkbox"/> Other: _____  |

1. Applicant's election of group I claims 1-4, 6, 7, and 8 in the reply filed on 11/21/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 4, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 line 6-7 "an angle of -45... a certain direction of the metal layer" is vague and indefinite because 1) -45 is unclear to the meaning of the phrase and 2) -45 is relative to a certain direction which is an unknown subjective element. See claims 4 lines 4, 9, and 13 for the same problem (certain direction). Also see claim 7 and 8 for all of the same problems as claim 4. To overcome these rejections simply cancel the claims.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Ogisu '837 (7082,837).

Ogisu'837, a Fuji Jukogyo Kabushiki Kaisha patent, teach a composite comprising a fiber reinforced layers, shape memory alloy (metal) layers, and a damage sensor

laminated to the resin layer which laminated to the shape memory alloy metal layer.  
See the abstract and Fig 1, for example. Ogis'837 further teaches a predetermined  
starin hass beedn applied to each layer ( or film).

5. Claim1 and 2 are rejected under 35 U.S.C. 102(e) as being clearly anticipated  
by Ogisu '286 (US 6986286).

Ogsui'286 is applied for all the reasons of record supra for Ogisu '837 since there  
disclosers are the same (division applications).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public  
use or on sale in this country, more than one year prior to the date of application for patent in the United  
States.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated  
by Ogisu'218 (US 6655218).

Ogisu'218 is applied for all the reasons supra for Ogisu' 837 since there disclosures are  
the same (division applications).

7. Claims 3 and 6 are objected to as being dependent upon a rejected base claim,  
but would be allowable if rewritten in independent form including all of the limitations of  
the base claim and any intervening claims.

Regarding the IDS dated 9/28/04, the lined references where not considered since  
applicant provided incorrect PGPub numbers.

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Any inquiry concerning this communication should be directed to Primary Examiner Edwards at telephone number 571-272-1521.

A handwritten signature in black ink, appearing to read 'N Edwards', is positioned above the printed name.

N Edwards  
Primary Examiner  
Art Unit 1774